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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/671,924

09/24/2003

Andrew S. Poulsen

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AGILENT TECHNOLOGIES INC.

INTELLECTUAL PROPERTY ADMINISTRATION,LEGAL DEPT.

MS BLDG. E P.O. BOX 7599

LOVELAND, CO 80537

EXAMINER

MOUTAOUAKIL, MOUNIR

ART UNIT

PAPER NUMBER

2476

NOTIFICATION DATE

DELIVERY MODE

10/28/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPOPS.LEGAL@agilent.com

Office Action Summary

Application No.

10/671,924

Applicant(s)

POULSEN, ANDREW S.

Examiner

MOUNIR MOUTAOUKIL

Art Unit

2476

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, and 14-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed on 08-17-2009 has been entered and considered.

Claims 1-12, and 14-25 are pending in this application.

Claim 13 is canceled.

Claims 1-12, and 14-25 remain rejected as discussed below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-12 and 14-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. Regarding claims 1-12 and 14-25, the specification does not contain sufficient information to enable the recitation of "an electronic test instrument". The specification does not explain what is the test instrument, what does the test instrument do, what is being tested, how does the test instrument generate the instrument data, what is the purpose if the test instrument and who will benefit from the tests generated. The specification provides insufficient guidance to enable one skilled in the art to perform the method of claims 1-12 and 14-25.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-12, 14-17, and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loveland (US 6,782,413).

Regarding claim 1. Loveland discloses an instrument system (fig.2). The system comprises an electronic instrument (130, 134, or 132); and a network interface module (114) having a first connector for connecting with the electronic test instrument (the connection between 130 and 114), a second connector for connecting with a voice module (137 and the connection between 137 and 114), and a third connector for connecting with a network (116), wherein the network interface module and the electronic instrument are configured to interchange instrument data via the first connector (computers, e-mails and servers exchange data through module 114), wherein the network interface module and the voice module are configured to interchange voice data via a second connector (137 communicate with the WAN through the 114), wherein the voice data is in the form of an electronic signal (it is inherent that voice data is in a form of electronic signal), wherein the network interface module and the network are configured to interchange combined voice and instrument data via the third connector (fig.2, 116 and col.7, lines 16-30. The network interface 114 combines voice and data and transmits them to the WAN through the third link 116), and wherein

the network interface module is configured to effect transposition between combined voice and instrument data and separate instrument data and voice data (fig.2, col.7, lines 16-30).

Claim 1 discloses all the limitations of the claimed invention with the exception that the electronic instrument is an electronic test instrument. However, examiner takes an official notice that it is well known and preferred in the art the computers can test the network by sending test packets, ping and traceroute commands to test the network, determine network topology, and determine liveness of network terminals or elements. Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to test the network using the electronic device of Loveland for at least the reasons stated above.

Regarding 2. Loveland discloses an instrument system wherein interchange of instrument data between the network interface module and the electronic instrument comprises the reception of instrument data from the electronic instrument by the network interface module (fig.2, 114, 128, 130, 132, and 134).

Regarding claim 3. Loveland discloses an instrument system wherein interchange of instrument data between the network interface module and the electronic instrument comprises the transmission of instrument data from the network interface module to the electronic instrument (fig.2. 114, 128, 130, 132, and 134).

Regarding claim 4. Loveland discloses an instrument system wherein interchange of voice data between the network interface module and the voice module

comprises the reception of voice data from the voice module by the network interface module (fig.2, 114, and 137).

Regarding claim 6. Loveland discloses an instrument system wherein interchange of voice data between the network interface module and the voice module comprises the transmission of voice data from the network interface module to the voice module (fig.2, 112, and 137).

Regarding claim 7. Loveland discloses an instrument system that further comprising the voice module, wherein the voice module comprises a transducer (137), wherein the transducer transforms electronic voice data into sounds replicating the human voice (137).

Regarding claim 8. Loveland discloses an instrument system wherein interchange of combined voice and instrument data between the network interface module and the network comprises the reception of a data stream comprising combined instrument data and voice-over-IP data from the network by the network interface module and wherein the network interface module transposes the combined instrument data and voice-over-IP data into separated instrument data and voice data (col.7, lines 16-31).

Regarding claim 9. Loveland discloses an instrument system wherein the network interface module transposes separated instrument data and voice data into combined instrument and voice-over-IP data and wherein interchange of combined voice and instrument data between the network interface module and the network

comprises the transmission of a data stream comprising the combined instrument and voice-over-IP data from the network interface module to the network (col.7, lines 16-31).

Regarding claims 14-16. Loveland discloses an instrument system wherein the voice module comprises a handset (137), wherein the handset/headset/speaker is used for communication with an operator (element 137 is used to communicate with people).

Regarding claim 18. Loveland discloses an instrument system wherein the network is a local area network (LAN) (fig.2, 110, col.6, lines 23-28).

Regarding claim 19. Loveland discloses an instrument system wherein the network is the internet (it is inherent that the network is the internet, since they exchange VOIP is supported by the system).

Regarding claim 20. Loveland discloses an instrument system wherein the network is a Wide-Area-Network (110).

Regarding claim 21. Loveland discloses an instrument system wherein the system enables communication between the electronic instrument and a remote system (fig.2).

Regarding claim 22. Loveland discloses an instrument system, wherein the system enables communication between an operator located with the electronic instrument and another individual located remote from the operator's location (fig.2).

Regarding claim 23. Loveland discloses an instrument system wherein diagnostic instrument data from the electronic instrument is transmitted to a remote data analysis instrument (fig.2).

Regarding claim 5. Loveland discloses an instrument system that further comprising the voice module, wherein the voice module comprises a transducer (it is inherent the phone set includes a transducer), wherein the transducer transforms the human voice into electronic voice data (it is inherent that the phone set 137 converts human voice into an electronic signal).

Regarding claim 10. Loveland discloses an instrument system that further comprising the voice module (137).

With respect to claims 5 and 10, Loveland discloses all the limitations of the claimed invention with the exception that the test instrument comprises a chassis and that the voice module is built into the chassis. However, it would have been obvious matter of design choice to modify Loveland by physically attaching all the elements listed above together into a chassis, since applicant has not disclosed that having all the elements, listed above, physically attached together into a chassis solves any stated problem or is for particular purpose and it appears that the system would function/perform equally well with the elements being separate.

Regarding claims 11 and 17. Loveland discloses all the limitations of the claimed invention with the exception that the voice module, the network module and the electronic instrument are physically attached. However, it would have been obvious

matter of design choice to modify Loveland by physically attaching all the elements listed above together, since applicant has not disclosed that having all the elements, listed above, physically attached together solves any stated problem or is for particular purpose and it appears that the system would function/perform equally well with the elements being separate.

Regarding claim 12. Loveland discloses an instrument system wherein the transducer is a speaker (137).

Regarding claim 24. Loveland discloses all the limitations of the claimed invention.

Loveland fails to disclose connecting to the network wirelessly. However, an official notice is taken that the person of ordinary skill in the art at the time of the invention will know how to modify the system to connect to the network wirelessly. The person of ordinary skill in the art will notice the need to connect to the network wirelessly to eliminate connection cabling, and enjoy portability and flexibility.

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Loveland in view of Lashley et al (US 7,003,085). Hereinafter, referred to Lashley.

Loveland discloses all the limitations of the claimed invention with the exception that the test instrument comprises a call button to connect the user to a support location to receive help. However, Lashley, from the same field of endeavor, discloses that a customer or user may simply press a customer support call button 116 to easily and quickly connect with a customer service representative for assistance and support.

Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to add a button, as taught by Lashley, into the method of Loveland for at least the reasons stated above.

Response to Arguments

8. Applicant's arguments filed 08-17-2009 have been fully considered but they are not persuasive.
 9. Applicant's representative argues that test instrument is clearly understood by PHOSITA (based on www.wikipedia.com).
 10. Examiner respectfully disagrees. Applicant's original disclosure does not contain sufficient information to enable the broad scope of the claims. For instance, what is being tested or what problem is being solved by the test instrument or which one of the types of test instruments is being used in the present application are unaddressed by the applicant's specification. Moreover, the definition supplied by the applicant's representative (based on www.wikipedia.com) is not issued on or before the filing date of the current application (09/24/2003). Therefore the 112 rejection is maintained.
 11. Applicant's representative argues that examiner has not made it clear for why it would have been obvious to configure the computer of Loveland as an electronic test instrument.
 12. Claims should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims.
- See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527

F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claim that are not recited in the claim.

13. Claims are given their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

14. Therefore, examiner takes an official notice that it is well known and preferred in the art that the computers can test the network by sending test packets, ping and traceroute commands to test the network, determine network topology, and determine liveness of network terminals or elements in a network. Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to test the network using the electronic device of Loveland for at least the reasons stated above. Consequently, the 103 rejection is maintained.

15. Note: based on MPEP 2144.03 "if applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate". Therefore, the common knowledge or well-known in the art statement is taken to be admitted prior art.

16. Furthermore: The prior art made of record and not relied upon is considered pertinent to the taken official notice. See PTO_892.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of. The art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOUNIR MOUTAOUAKIL whose telephone number is (571)270-1416. The examiner can normally be reached on Monday-Thursday (1pm-4:30pm) Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. M./
Examiner, Art Unit 2476

/Ayaz R. Sheikh/

Supervisory Patent Examiner, Art Unit 2476